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REMARKS

Claims 1-76 are currently pending in the subject application and are presently under consideration. Claim 72 has been amended to correct a grammatical error. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 39, 40 and 72-76 Under 35 U.S.C. §102(e)

Claims 39, 40 and 72-76 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ellis (US 2005/0028208). Withdrawal of this rejection is respectfully requested for at least the following reasons. Ellis does not disclose each and every limitation of the claims.

A single prior art reference anticipates a patent claim if *each and every* limitation set forth in the patent claim is disclosed in the reference, either expressly or inherently. (See *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599, 2 U.S.P.Q.2d 1051, 1052-53 (Fed. Cir. 2002) (citing to *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987))) (emphasis added). Moreover, “[t]he *identical* invention must be shown in as *complete* detail as is contained in the patent claim.” (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added) (citing *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 U.S.P.Q. 253, 257 (Fed. Cir. 1985); and *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983))).

All of the subject claims recite the limitations a token service system configured to provide token services *to a program provider*, the token services comprising one or more services *additional to programming the associated device*; and wherein the token service system *monitors token translation to provide token services to the program provider* based on the token program criteria or similar limitations. The Examiner contends that Ellis discloses providing token services to a program provider “such as program guide information service, parental setting, favorite channels, etc., to television distributing facility” and “providing recording of the selected program.” (Office Action dated Aug. 9, 2005 at p. 4). Applicants’

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representative respectfully disagrees. The services listed by the Examiner (program guide information, parental settings and favorite channels) are services provided to the *viewer*, not services provided to a program provider. (See *e.g.*, Ellis at para. 0099). Moreover, providing recording of the selected program is neither a service provided to the program provider nor a service *in addition to* programming the associated device (as is recited in the subject claims). Examples of token services provided to a program provider are described in the Application (*e.g.*, sending demographic and marketing information to the program provider, etc.). (See *e.g.*, Application at p. 12). Ellis does not disclose any such services.

The Examiner also contends that “token translation (ID of tuned channel, title of program, device available, etc.) is inherently monitored to obtain the audio and/or video program content from the token to provide services (program guide information services) to a program content provider (distribution facility 16).” (Office Action at p. 4). Applicants’ representative respectfully disagrees. As explained *supra*, programming a VCR and setting parental controls and favorite channels are performed by the user to benefit the user, and are not services provided to a program provider. Similarly, providing program guide information services is a service provided *by* the program provider *to a user*, but not a service provided *to* the program provider. Thus, Ellis does not disclose monitoring token translation *to provide token services to a program provider* as recited in the subject claims.

Moreover, the Examiner concedes that Ellis does not disclose a “message having an associated token.” (Office Action at p. 9). Accordingly, Ellis cannot disclose monitoring token translation if Ellis does not disclose the use of a token to program a device. In view of at least the foregoing, it is readily apparent that Ellis does not anticipate the subject claims, and applicants’ representative respectfully requests that this rejection be withdrawn.

II. Rejection of Claims 1-38 and 41-71 Under 35 U.S.C. §103(a)

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Claims 1-38 and 41-71 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis (US 2005/0028208) in view of Hirata (US 6,374,406). Withdrawal of this rejection is respectfully requested for at least the following reasons. As explained *supra*, Ellis does not teach or suggest a token service system configured to provide token services *to a program provider*, the token services comprising one or more services *additional to programming the associated device*; and wherein the token service system *monitors token translation to provide token services to the program provider* based on the token program criteria. Hirata does not remedy this deficiency. Moreover, there is no teaching, suggestion, or motivation to combine the teachings of Ellis and Hirata and the Examiner has not provided any *evidence in the prior art or other reference of record* to show otherwise.

The test of obviousness is whether "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." (*Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966); *see also e.g., In re Dembiczak*, 175 F.3d 994, 998, 50 U.S.P.Q. 1614, 1616 (Fed. Cir. 1999)). In evaluating obviousness, the PTO must conduct the factual inquiry as outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). (*See In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002)). The factual inquiry to be conducted includes determining: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. (*See Graham*, 383 U.S. 1, 17-18 (1966)). The PTO must "not only assure that the requisite findings are made, *based on evidence of record*, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434) (emphasis added). *The PTO cannot rely merely on conclusory statements* and assertions of "common sense" to remedy deficiencies of the cited references. (*In re Lee*, 277 F.3d at 1344, 61 U.S.P.Q.2d at 1434) (emphasis added). If the PTO relies on multiple prior art references as the basis for an obviousness rejection, it is not enough that all of the claim limitations appear in the prior art. To establish a *prima facie* case of obviousness, the PTO must also make an adequate showing of a suggestion, teaching, or motivation to combine the prior art references. (*See In re Dembiczak*, 175 F.3d 994, 999-1001, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999) (citing to *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232

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(Fed. Cir. 1998)); *see also In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433). Only if the PTO establishes a *prima facie* case of obviousness does the burden of coming forward with evidence or argument shift to the applicant. (*See In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992)).

The Examiner contends that it would be obvious to combine the teachings of Ellis with those of Hirata "in order to provide an alternative way to send control information in Internet medium." (Office Action at p. 10). However, the Examiner does not point to any *evidence* that supports this contention. Thus, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art but, rather, suggested by the advantages disclosed in applicants' specification.

This sort of approach has been repeatedly condemned by the Court of Appeals for the Federal Circuit (CAFC) as entering the "tempting but forbidden zone of hindsight." (*In re Dembiczak*, 175 F.3d at 998, 50 U.S.P.Q. at 1616 (citing to *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 U.S.P.Q. 90, 98 (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 U.S.P.Q.2d 1097 (Fed. Cir. 1998))). By imbuing "one of ordinary skill in the art with knowledge of the invention in suit when *no prior art reference or references of record* convey or suggest knowledge," the Examiner has fallen "victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (*In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (citing to *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)) (emphasis added); *see also In re Dembiczak*, 175 F.3d at 998-99, 50 U.S.P.Q. at 1616-17). As the CAFC has stated:

[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art references *without evidence* of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--

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the essence of hindsight. . . . [T]he showing must be *clear and particular*. *Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."*

(*In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q. at 1617) (internal citations omitted) (emphasis added). Indeed, all the Examiner has done is provide the "[b]road conclusory statements" that the Federal Circuit has held are not *evidence* that can support an obviousness rejection. (*In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q. at 1617). For at least the foregoing reasons, Applicants' representative respectfully requests that this rejection be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP111USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731